

Serial No.: 10/072,429

1. Claims 1, 8, 11, 12 and 16 were rejected under §103(a) over Peters '112 in view of Besnard '112. Claims 7 and 15 were rejected under §103(a) over Peters and Besnard, further in view of JP '656 and Fenton '036.

Because the rejections (with the exception of their new application to additional claim 16) are identical to the rejections made in the prior Office Action, applicants hereby incorporate by reference all of the arguments presented in the remarks of the prior amendments during prosecution of this application. Additionally, since the Office Action makes a "Response to Arguments," applicants offer the following additional points to assist in reconsideration of applicants' positions in this application.

The Office Action erroneously assumes that Peters discloses varying the weighting of club heads within a set, and therefore discloses varying the volume and number of recesses among club heads within a set. Specifically, the Office Action p. 6, lines 2 and 3, states that "[i]n Peters, figures 20 and 22 clearly show different amounts of recesses on a rear face." The Office Action, further contends:

Serial No.: 10/072,429

Figures 20 and 22 show the method of changing the volume of the weights added to the bottom of the heads. This would be an obvious method useable to one skilled in the art for set 158 though not specifically stated due to what the drawings teach and what experience one skilled in the art brings to the patent of Peters.

Office Action, p. 6, lines 11-15. Thus, the Office Action argues that Peters' Figs. 20 and 22 would be understood by one of ordinary skill in the art to teach changing the volume of the weights added to the bottoms of two different club heads within the same set even though Peters admittedly does not specifically state this.

But Peters teaches a correlated set of golf clubs. "[G]olfers typically purchase the irons as a correlated set which includes a large range of clubs. The clubs in such a set are designed to work together..." Col. 1, lines 38-40; see also col. 3, lines 34-35 and col. 3, lines 56-57. A correlated set "comprises two or more clubs which contain the same design characteristics and are sold together as a set." Karsten Manufacturing Corp. v. Cleveland Golf Co., 242 F.3d 1376, 58 USPQ 2d 1286 (Fed. Cir. 2001). Peters additionally teaches that "the entire set 30 of clubs is packaged within a single piece of

Serial No.: 10/072,429

packaging, such as a carton designed for shipment and, preferably, display of the set of irons" (col. 7, lines 4-7).

Thus Peters expressly teaches away from using embodiments exemplified in Figs. 20 and 22 together in the same set. According to Peters these are two different embodiments of the same club head of a set, rather than two different club heads in the same set. Peters states that "[w]ith references to FIGS. 20 and 21, there is shown an exemplary club head 76b from the second group 158" but "[i]n another embodiment of the club head 76b shown in Fig. 22, the weight inserts 174 and 176 are replaced by a single weight insert 178...." Emphasis added here. Peters discloses two different embodiments of the same club head 76b, which would exist in two different sets, rather than two different club heads designed to be sold together in a single correlated set of clubs. Thus, both the Peters' disclosure (i.e., the different embodiments exemplified in Peters' Figs. 20 and 22) and the customary usage of the term 'correlated set' in the art of golf club making, teach those skilled in the art away from changing the volume of the weights in two golf club heads within a single set of irons.

Serial No.: 10/072,429

Peters also teaches away from a set of clubs wherein *all irons* share a common design characteristic.

Unfortunately, the performance of the specific clubs in a set may be adversely affected if all of the clubs include the same basic design characteristics. For example, the increased precision of the blade design may not be optimal for the long irons, where the emphasis should be toward enhancing the playability of the clubs by making it easier to get the ball airborne. Likewise, the cavity-back design is not necessarily suited for the shortest irons, which should emphasize feel and feedback and, therefore, controllability of the ball.

Peters, col. 2, lines 49-58.

The design characteristics of the clubs should be specifically directed toward improving the specific playing needs of each of the clubs or groups of clubs in the set. For example, the properties of easy playability and forgiveness should be promoted for the long irons. The property of controllability of the shot should be promoted for the short irons. The middle irons should preferably be designed to compromise between playability and precision. These objectives are not necessarily accomplished if the clubs in a correlated set are united by a single, basic design characteristic. There is therefore a need for a correlated set of golf clubs wherein each club or a group of clubs in the set utilized technology that is specifically designed to promote the playing needs of that particular type of club.

Peters col. 3, lines 1-15; also see col. 2, lines 59-68.

Serial No.: 10/072,429

Applicant's claim 1 recites:

A set of golf club irons, each iron of said set having ... a cavity ... at least one recess in the upper wall ... wherein a volume of said at least one recess inside said upper wall varies from one iron to another within said set to cause the center of gravity of each head to vary in distance relative to said upper face from one iron to another.

Thus, claim 1 recites a set of golf club irons wherein all irons of the set share such basic design characteristics as cavity-back construction and variation in volume of the recess to cause changes in CG location, which is contrary to the teachings of Peters.

It remains applicants' position that there is no disclosure, teaching, suggestion or motivation in either Peters or Besnard which would have made it obvious to modify Peters' irons to have at least one recess in the upper wall thereof. And, there is nothing in either of those references which would in any way suggest modifying the other reference so that the volume of any such recess in the upper wall varies from one iron to another within the set causing the center of gravity of each club head in the set to vary in distance relative to the upper face from one iron to another. The Office Action simply

Serial No.: 10/072,429

erroneously and unlawfully assimilates applicants' disclosed and claimed invention into the prior art, with no basis for doing so in the prior art itself.

For all the foregoing reasons, there is no disclosure or teaching in any of Peters, Besnard, JP '656 or Fenton which discloses or teaches all the elements of any of applicants' claims. Further, there is no disclosure, teaching, suggestion or motivation in any of those references which suggests the desirability of combining any portions thereof effectively to anticipate or suggest applicants' presently claimed invention.

For all of the foregoing reasons, all claims 1, 7, 8, 11, 12, 15 and 16 are patentably distinguished over all grounds of rejection cited in the Office Action. Accordingly, allowance of all claims 1, 7, 8, 11, 12, 15 and 16 is respectfully solicited.

Serial No.: 10/072,429

Should the Examiner deem that any further amendments would be desirable in placing this application in even better condition for issue, he is invited to telephone applicants' undersigned representative.

Respectfully submitted,

STEPTOE & JOHNSON LLP

Aug 29, 2005  
Date

RWP/ch  
Atty Dkt: 28952.5481

Roger W. Parkhurst  
Roger W. Parkhurst  
Registration No. 25,177

STEPTOE & JOHNSON LLP  
1330 Connecticut Ave., N.W.  
Washington, D.C. 20036  
(202) 429-6415